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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/031,161	05/20/2002	Nikolai Grigorievich Lyapko	PAA-101-A	4995

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06/07/2005

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EXAMINER

THANH, QUANG D

ART UNIT	PAPER NUMBER
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3764

DATE MAILED: 06/07/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/031,161

Applicant(s)

LYAPKO, NIKOLAI
GRIGORIEVICH

Examiner

Quang D. Thanh

Art Unit

3764

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 May 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 19-34 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 19-34 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. This office action is responsive to the amendment filed on 5/6/05. As directed by the amendment, claims 19 and 27 have been amended and no claims has been added. Thus, claims 19-34 are presently pending in this application.
2. The finality of the rejection of the last Office action dated 5/4/04 is withdrawn in view of Applicant's request for reconsideration stated in Applicant's statement of interview summary filed on 5/6/05.

Response to Amendment

3. The amendment filed 5/6/05 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: "two layers" in claim 27.

Applicant is required to cancel the new matter in the reply to this Office Action.

Claim Rejections - 35 USC § 103

4. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
5. Claims 19, 21, 23, 27, 29, 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gelfer et al in view of Leupold.
6. Re claims 19, 21 and 23, Gelfer teaches a body treatment pad having a flexible base member 10 made of plastic material and a plurality of needles 19 each having a thickened end and a sharpened tip 23 (fig. 6) being tapered from the thickened end

toward the sharpened end (fig. 6). Since the base member is made of plastic material and has sufficient flexibility (col. 3, lines 4-10), therefore it has a certain degree of elasticity. Gelfer does not disclose the thickened end of the needle being embedded inside of the base member. However, Leupold teaches that a needle 8 may be embedded in a base material (see fig. 3), the needle having a thickened end 9 in the form of a head (fig. 3 shows thickened end head 9). Therefore, it would have been obvious to one skilled in the art to embed the needles having a thickened end head within the base, as taught by Leupold, for the purpose of further stabilizing the anchoring of the needles to the base, thus preventing the needles from breaking off. Regarding the steps of making the pad recited in these claims, it is noted that such steps are being considered as a product-by-process limitations and thus are not given patentable weight, as they do not further limit the structure of the device.

7. Re claims 27, 29 and 31, the device of Gelfer as modified by Leupold teaches a body treatment pad having a flexible base member 10 made of plastic material and a plurality of needles 19 embedded in the base member, each having a thickened end and a sharpened tip 23 (fig. 6) being tapered from the thickened end toward the sharpened end (fig. 6), the thickened end has the form of a head (Leupold, fig. 3 shows thickened end head 9), except for the two layers. However, Gelfer already teaches that the base member 10 is a sheet made of plastic material, and it would have been obvious to one having ordinary skill in the art at the time the invention was made to select two or more layers of plastic material to form the sheet, with the needles embedded between the layers in the base member, as taught and suggested by

Leupold, since it has been held that constructing a formerly integral structure in various elements involves only routine skill in the art. *Nerwin v. Erlichman*, 168 USPQ 177, 179.

8. Claims 20, 22, 24-26, 28,30, 32-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gelfer et al in view of Leupold as applied to claims above, and further in view of Yoneda et al. The device of Gelfer et al as modified by Leupold does not disclose lugs surrounding the needles and being disposed on the base member. However, Yoneda et al disclose a cone or pyramidal shaped needle (fig. 2 and 6) that could be modified in the form of a nail shaped needle 12 which includes an increased thickness 15, with a lug 13 (best seen in fig. 7 and 8). Therefore, it would have been obvious to one skilled in the art to modify the needle of Gelfer modified by Leupold to have lugs disposed on the base member and surrounding the needles, as taught by Yoneda, for the purpose of providing a lug to serve as stabilizing means that allows for increased retention of the needle.

Response to Arguments

9. Applicant's arguments filed 5/6/05 have been fully considered but they are not persuasive.

10. In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon

hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

11. In response to applicant's argument that the reference does not disclose "A device for reflexology", a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 370 F.2d 576, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 312 F.2d 937, 939, 136 USPQ 458, 459 (CCPA 1963).

12. In response to applicant's argument that "three references must be combined to allegedly meet claims 20, 22-26, 28 and 30-34 is evidence of unobviousness", it is noted that reliance on a large number of references in a rejection does not, without more, weigh against the obviousness of the claimed invention. See *In re Gorman*, 933 F.2d 982, 18 USPQ2d 1885 (Fed. Cir. 1991).

13. In response to applicant's argument that the prior references "are from different technical fields (acupuncture) than that of applicant's invention (reflexology)" thus are nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem

with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, it is well known in the art that acupressure therapy taught in the prior art is also referred to as reflexology massaging since both involve applying pressure to meridian points of the body, as clearly shown in col. 1, lines 11-31 of Bukowski (5,058,073). Therefore, the examiner maintains that prior art references are analogous art with the applicant's invention.

14. In response to applicant's argument that "the fact that the applied references each teach features aimed at solving different problems is not sufficient to gratuitously and selectively substitute part of one reference (Leupold) for a part of another reference (Gelfer) in order to meet applicant's novel claimed combination", the fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985).

15. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Gelfer discloses

the claimed invention having all the features, except for the needle being embedded in the base member and lug surrounding the needle. Leupold is cited to teach a similar acupuncture device having a needle embedded in a base material (see fig. 3). Therefore, it would have been obvious to one skilled in the art to embed the needles within the base, as taught by Leupold, for the purpose of further stabilizing the anchoring of the needles to the base, thus preventing the needles from breaking off. Yoneda is further cited to teach a similar device having a nail shaped needle 12 which is surrounded by a lug 13 (best seen in fig. 7 and 8). Therefore, it would have been obvious to one skilled in the art to include lugs disposed on the base member and surrounding the needles, as taught by Yoneda, for the purpose of providing a lug to serve as stabilizing means that allows for increased retention of the needle during use.

Conclusion

16. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Quang D. Thanh whose telephone number is (571) 272-4982. The examiner can normally be reached on Monday-Thursday & alternate Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Greg Huson can be reached on (571) 272-4887. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306 for both regular and After-Final communications.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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